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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,399	12/23/2004	Koji Okomori	47172	2492
1609	7590	09/15/2005		
ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P. 1300 19TH STREET, N.W. SUITE 600 WASHINGTON,, DC 20036			EXAMINER BAREFORD, KATHERINE A	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 09/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/501,399

Applicant(s)

OKOMORI ET AL.

Examiner

Katherine A. Bareford

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

*Claim 1 is canceled*

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/04</u> . | 6) <input type="checkbox"/> Other: ____  |

*15*

*10*

## DETAILED ACTION

### *Specification*

1. The abstract of the disclosure is objected to because the abstract should be in the form of a single paragraph.

Correction is required. See MPEP § 608.01(b).

### *Claim Objections*

2. Claims 3-4 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

As worded, it is unclear how claims 2 and 3 further limit the parent claim as no process limitation is provided to limit the parent claim. While reference to offset (claim 3) and gravure (claim 4) printing is made, this is in the preamble of the claim and as such does not limit the method claim.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 5-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5, lines 5-6, "0.1 to less than 2.0 parts by weight of the pigment of polyvinyl alcohol as an auxiliary" is confusing as to what amount of weight is required. Does applicant mean "0.1 to less than 2.0 parts by weight of polyvinyl alcohol per 100 parts by weight of the pigment as an auxiliary" as described in claim 2 above?

The other dependent claims do not cure the defects of the claims from which they depend.

#### *Claims*

5. As to the use of "a film transfer method" in the claims, the Examiner understands this to require a roll coating method as described at page 1 of the specification. If applicant disagrees, he should so state on the record.

#### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2-3 and 5-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saji et al (US 5030325) in view of Hershey et al (US 4154899).

Saji teaches a method of producing coated paper for printing. Column 2, lines 15-30 and column 1, lines 10-20. A coating color containing a pigment and an adhesive is applied on a base paper. Column 2, lines 15-30. The coating color can contain polyvinyl alcohol and starch as adhesives. Column 4, lines 10-30. The adhesive can be 5-50 wt parts per 100 wt parts pigment. Column 4, lines 25-35. The applied coating weight can be 50 g/m<sup>2</sup>. Column 4, lines 60-65. The coating can be applied to the paper by various methods, such as blade coating, a roll coater, a reverse roll coater, a gravure coater, a size press coater etc. Column 4, lines 40-48. A coated paper is provided for printing. Column 2, lines 15-30 and column 1, lines 10-20.

Saji teaches all the features of these claims except (1) the precise amounts of polyvinyl alcohol (claim 2), (2) the offset printing (claim 3), (3) the amount of starch (claim 5), (4) the transfer roll coater method (claim 8).

Hershey teaches a method for producing coated paper for printing. Column 2, lines 15-30. A coating color containing a pigment and an adhesive is applied on a base paper. Column 2, lines 30-40. The coating color can contain 1.5 parts by weight of polyvinyl alcohol per 100 parts by weight of the pigment. Column 12, lines 5-10 and 30-55 (Example 8). The applied coating weight can be 12 lbs/ream (> 7 g/m<sup>2</sup>) (for example 10 lbs/ream is approx. 14.6 g/m<sup>2</sup>). Column 3, lines 10-15. Hershey teaches to apply the coating by blade coating. Column 2, lines 15-25. The paper can be for offset

printing. Column 2, lines 25-30. The coating can also be 1.5 parts by weight of starch as an adhesive per 100 parts by weight of the pigment. Column 12, lines 5-10 and 30-55 (Example 8). The amount of adhesive can be less than 18 parts by weight per 100 parts by weight of the pigment (note Example 8, which has 15 parts by weight). Column 12, lines 5-10 and 30-55 (Example 8). A coated paper is produced. Column 2, lines 15-30.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saji to use the paper for offset printing and to use the starch and polyvinyl alcohol amounts suggested by Hershey in order to provide a desirable paper for a process such as offset printing, because Saji teaches that a desirable paper for printing is coated with pigments and adhesives that can include starch and polyvinyl alcohol, and Hershey teaches that desirable papers for printing made by coating with pigments and adhesives can be used in offset printing and that desirable amounts of starch and polyvinyl alcohol are 1.5 wt parts per 100 weight parts of pigment for each. It further would have been obvious to modify Saji in view of Hershey to use a transfer roll coater as the film transfer method with an expectation of achieving a desirable coating, as Saji teaches that a variety of roll coating (film transfer) methods can be used, and it is the Examiner's position that transfer roll coating is a well known method of roll coating.

8. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Saji in view of Hershey as applied to claims 2-3 and 5-9 above, and further in view of Lee et al (US 4258104).

Saji in view of Hershey teaches all the features of this claim except the use of the paper for gravure printing.

However, Lee teaches that when coating a paper with adhesive and pigment for printing purposes, a desirable printing process to be provided on the paper is a rotogravure (a type of gravure) printing. Column1, lines 1-25, column 11, lines 5-20 and column 13, lines 30-36.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saji in view of Hershey to provide that the paper is printed with a gravure printing process as suggested by Lee in order to provide a desirable printed paper, because Saji in view of Hershey teaches to provide a pigment/adhesive coated paper for a printing process, and Lee teaches that when providing a pigment/adhesive coated paper for a printing process, a desirable printing process to be used is a rotogravure process.

### *Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:00-3:30) with the First Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and for After Final communications.

Other inquiries can be directed to the Tech Center 1700 telephone number at (571) 272-1700.

Furthermore, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
KATHERINE BAREFORD  
PRIMARY EXAMINER